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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,884	02/05/2002	Andrew Baxter	06275-233001	7953

7590

04/24/2003

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EXAMINER

TRUONG, TAMTHOM NGO

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 04/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/868,884

Applicant(s)

BAXTER ET AL.

Examiner

Tamthom N. Truong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, and 20-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-11, and 20-26 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Applicant's amendment of 2-14-03 has been considered. Although the amended claims have overcome the previous rejections of 112/2nd paragraph and 102, a complete search on its entire scope cannot be carried out, especially for the species in claim 8. Therefore, the following restriction is presented.

Claims 1-11, and 20-26 are pending.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-11, and 20-26 (part of each), drawn to compounds of formula (I) wherein A is **thiophene**, and R¹ is **phenyl**; their preparation, pharmaceutical composition and methods of treatment.

Group II, claim(s) 1-3, 5-11, and 20-26 (part of each), drawn to compounds of formula (I) wherein A is **furan** and R¹ is **phenyl**; their preparation, pharmaceutical composition and methods of treatment.

Group III, claim(s) 1-3, 5-11, and 20-26 (part of each), drawn to compounds of formula (I) wherein A is **pyrrole**, and R¹ is **phenyl**; their preparation, pharmaceutical composition and methods of treatment.

Group IV, claim(s) 1-3, 5-11, and 20-26 (part of each), drawn to compounds of formula (I) wherein A is **imidazole**, and R¹ is **phenyl**; their preparation, pharmaceutical composition and methods of treatment.

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Group V, claim(s) 1-3, 5-11, and 20-26 (part of each), drawn to compounds of formula (I) wherein A is **thiazole**, and R¹ is **phenyl**; their preparation, pharmaceutical composition and methods of treatment.

Group VI, claim(s) 1-3, 5-11, and 20-26 (part of each), drawn to compounds of formula (I) wherein A is **thiazole**, and R¹ is **phenyl**; their preparation, pharmaceutical composition and methods of treatment.

Group VII, claim(s) 1-3, 5-11, and 20-26 (part of each), drawn to compounds of formula (I) wherein A is **oxazole**, and R¹ is **phenyl**; their preparation, pharmaceutical composition and methods of treatment.

Group VIII, claim(s) 1-3, 5-11, and 20-26 (part of each), drawn to compounds of formula (I) wherein A is **thiophene**, and R¹ is **thienyl**; their preparation, pharmaceutical composition and methods of treatment.

Group IX, claim(s) 1-3, 5-11, and 20-26 (part of each), drawn to compounds of formula (I) wherein A is **thiophene**, and R¹ is **pyrimidinyl**; their preparation, pharmaceutical composition and methods of treatment.

Group X, claim(s) 1-3, 5-11, and 20-26 (part of each), drawn to compounds of formula (I) wherein A is **thiophene**, and R¹ is **pyridyl**; their preparation, pharmaceutical composition and methods of treatment.

Group XI, claim(s) 1-3, 5-11, and 20-26 (part of each), drawn to compounds of formula (I) wherein A is **thiophene**, and R¹ is **pyrazinyl**; their preparation, pharmaceutical composition and methods of treatment.

Group XII, claim(s) 1-3, 5-11, and 20-26 (part of each), drawn to compounds of formula (I) wherein A is **thiophene**, and R¹ is **thiazolyl**; their preparation, pharmaceutical composition and methods of treatment.

Group XIII, claim(s) 1-3, 5-11, and 20-26 (part of each), drawn to compounds of formula (I) wherein A is **thiophene**, and R¹ is **isoxazolyl**; their preparation, pharmaceutical composition and methods of treatment.

Group XIV, claim(s) 1-3, 5-11, and 20-26 (part of each), drawn to compounds of formula (I) wherein the combination of A and R¹ is not mentioned in the above groups; their preparation, pharmaceutical composition and methods of treatment.

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The inventions listed as Groups I - XIV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

- a. The special technical feature in this case is the combination of R¹-A.
- b. Although said groups share the functional groups of urea and caboxamide, said special technical feature(s) does not define a contribution over the prior art, i.e., it can be anticipated by or obvious in view of the prior art.

Due to the complexity of the groupings, a written restriction is presented herein.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 703-305-4485. The examiner can normally be reached on M-F (9:30-5:00) & every Saturday morning (starting from 4-7-03).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Tamthom N. Truong

Examiner

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April 23, 2003